



Best Practices - Suggestions and Tips: Avoid The Most Common Mistakes Made By Practitioners:

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Avoid Mistakes Throughout Prosecution

- Tips and Suggestions
 - Preparing the Application
 - Filing the Application
 - Avoiding Publication Pitfalls
 - Examination Processing Tips
 - Post Allowance Tips
 - Best Practice Tips (*see Appendix*)



Preparing the Application

- Avoid submitting an application in the European problem/solution format.
 - Format the application according to US rules and procedures. See MPEP § 608
- Avoid including multiple dependent claims that depend from other multiple dependent claims
 - Craft claims according to US practice, see MPEP § 608.01(n)
- Avoid including "Use" claims
 - Craft claims according to US practice, see MPEP § 608.01(k)



Pre-Examination Tips

Forms

- Do use USPTO forms without altering the language.
- Do not use a combined declaration and power of attorney form.
- USPTO forms can be found at:
<http://www.uspto.gov/web/forms/index.html>



Pre-examination Tips

Application Data Sheets

- Do use an Application Data Sheet (ADS), although an ADS is not required. Customers using an ADS can expect two advantages when applying for a patent:
 1. Improved accuracy of filing receipts.
 2. Accurately recorded application data.



Pre-examination Tips

Application Data Sheets (Cont'd)

- Use of a supplemental ADS is possible even though no original ADS was submitted on filing.
- The following information can be supplied on an ADS:
 - Application Information
 - Applicant Information
 - Correspondence Information
 - Representative Information
 - Domestic Priority Information
 - Foreign Priority Information
 - Assignment Information



Pre-examination Tips

Preliminary Amendments In New Applications

- Avoid submitting Preliminary Amendments on filing
- A substitute specification will be required if a preliminary amendment present on filing makes changes to the specification, except for:
 - Changes to title, abstract, claims or addition of benefit claim information to the specification
 - See the notice "*Revised Procedure for Preliminary Amendments Presented on Filing of a Patent Application*," 1300 Off. Gaz. Pat. Office 69 (November 8, 2005), available at:

<http://www.uspto.gov/web/offices/com/sol/og/2005/week45/patrevs.htm>



Pre-Examination Tips

Preliminary Amendments in Continuations and Divisionals

- Avoid submitting Preliminary Amendments on filing a Continuation or Divisional
- Avoid Preliminary Amendments that cancel all the claims and add new ones



Filing the Application

- Select a method of filing the application
 1. Accelerated Examination
 2. EFS-Web
 3. Traditional Mail Route



Filing the Application

- Accelerated Examination Common Failings
 - Failure to provide the text search logic. A mere listing of terms will not suffice.
 - Failure to search the claimed invention. The petition for accelerated examination may be dismissed if the search is not commensurate in scope with the claims.
 - Failure to show support in the specification and/or drawings for each limitation of each claim.



Filing the Application

- Accelerated Examination Common Failings (Cont)
 - Failure to show support in the specification and/or drawings for each limitation of each claim for every document whose benefit is claimed.
 - Failure to specifically identify the limitations in each claim that are disclosed in each reference.



Filing the Application

EFS-Web Filing

- Avoid coding (identifying) a Request for Continued Examination (RCE) as an "Amendment" when filing an RCE
- Avoid identifying papers after the initial filing as "new"
- Avoid common PCT filing mistakes
- Avoid filing color images or images that have a resolution higher than 300x300 dots per inch (dpi)



Avoid Publication Pitfalls

Nonpublication Requests

- Avoid inconspicuous requests for nonpublication.
- Publication will generally include all preliminary amendments submitted in time to be included in the publication.
- If amendments to the specification are desired to be included in publication, submit a substitute specification.



Avoid Publication Pitfalls

Publication Corrections

- Practitioners must include the assignment information in the transmittal letter or ADS.
- Avoid misspelling the names of inventors or assignees.
- Review the filing receipt promptly so that corrections can be requested before publication or export of data for publication.
- Avoid filing requests for Corrected Publication 37 CFR § 1.221(b) that fail to recite material errors.



Examination Processing Tips

General Prosecution Advice

- Amendments to the claims and/or specification should be accompanied by a written statement indicating specific support for the change. If the support is implicit, an explanation is beneficial.
- In response to restriction requirements, where inventions are indeed patentably indistinct, applicants should present arguments to that end.
- Read the entire prior art reference cited by the examiner, not just the part relied upon by the examiner in the rejection.



Examination Processing Tips

Pre-Appeal Brief Conference

- Avoid sending the request separate from the Notice of Appeal.
- Avoid making a request when there is an outstanding after-final amendment.
- Avoid attaching more than five pages to the cover form.
- Avoid sending in a supplemental request.
- Avoid paying a second Notice of Appeal fee in the application.



Examination Processing Tips

Filing of Continuation-in-Part (CIP) Applications

- Consider prosecuting an improved CIP invention independently of the prior invention:
 - File, if need be, a continuation only to the original invention, or take an appeal on the original invention, and
 - File a new application, rather than a CIP, for only the new invention:
 - without a benefit claim (35 U.S.C. §120, 37 CFR § 1.78) to the initial application, and
 - therefore without shortening the patent term of the initial invention if it were to be included in the CIP application, as
 - any benefit claim in a CIP cannot protect the new invention.



Post Allowance Tips

Issue Fee Payments

- Avoid filing an Information Disclosure Statement (IDS) after payment of the issue fee.
 - File an IDS filed after payment of the issue fee with a Petition for Withdrawal from Issue (37 CFR 1.313(c)) and an RCE (37 CFR § 1.114). Otherwise, the IDS will be placed in the file and the cited documents will not be considered by the examiner.
- Avoid delays in paying the issue fee.
 - The issue fee payment may be submitted via facsimile to the Office of Patent Publications ((571) 273-2885) or EFS-Web to ensure the payment is received within the non-extendable time period set forth in the Notice of Allowance and Fee(s) Due (PTOL-85).



Post Allowance Tips

Withdrawal from Issue

- Petitions to Withdraw from Issue may be hand carried or sent via facsimile to the Office of Petitions.
 - Hand carries should be brought to the security guard station of the Madison West building, 600 Dulany Street, Alexandria VA 22314.
 - The facsimile number for the Office of Petitions is (571) 273-0025.

Note: All other types of petitions must be directed to the Central FAX ((571) 273-8300).



Thank You.



APPENDIX

BEST PRACTICES



Best Practices

Use of S-signatures (37 CFR § 1.4(c)(2))

- A practitioner creates a document and S-signature signs it on his/her PC. The practitioner can then:
 - Facsimile transmit the document directly from the PC to the Office; or
 - Print the document and then facsimile transmit, mail, or hand-carry the document to the Office.
- An affidavit under 37 CFR § 1.132 is S-signed by the party making the affidavit, the S-signed affidavit is then:
 - Electronically sent to the practitioner, e.g., via an e-mail. The practitioner can then facsimile transmit, mail or hand-carry the S-signature signed document to the Office.



Best Practices

- Power of Attorney Tips:
 - Do direct a Power of Attorney to the Attorneys Associated with the Customer Number to the Customer Number
 - Do provide a separate Power of Attorney and a separate Oath/Declaration



Best Practices

- Priority Document Exchange Tips
 - Do provide a valid power of attorney with a submission for permission to access
 - Only the designated attorney or agent may grant permission to access.



Best Practices

Fee Payment Tips

- Avoid placing a stop payment on a check for USPTO services or to circumvent the rules of practice. This action is not appropriate.
 - Request a refund (37 CFR § 1.26) where fees were paid by mistake or in excess of the amount required.
- Avoid drafting a check to the USPTO for services on an account with insufficient funds.
 - Ensure that the account from which the check is drawn contains sufficient funds prior to submitting the check to the USPTO.



Best Practices

Fee Payment Tips

- Do use a Deposit Account Number on a transmittal form authorizing payment
 - Do not use a Customer Number to authorize payment of fees.
- Be clear with payment authorization statements.
 - Avoid contradictory statements on payment



Best Practices

Maintenance Fees/Deposit Accounts

- Maintenance fees and replenishing of deposit accounts at the USPTO can be done online:
<https://ramps.uspto.gov/eram>
- Inquiries related to deposit accounts, maintenance fees and refunds may be directed to the Office of Finance (571) 272-6500.



Best Practices

Prosecution Tips

- Proofread claims for clarity and precision
- Present all cogent arguments and evidence before final rejection
- If the examiner is believed to be ignoring a claim limitation, a personal or telephonic interview may facilitate the prosecution to completion.



Best Practices

Prosecution Tips (cont'd)

- Don't initiate a response on the absolute last day of the statutory period, if possible.
- Don't personally attack the Examiner in a response to Office Action.
- Follow the chain of command for assistance:
 - First, call the Examiner.
 - If he or she is non-responsive or unavailable, contact the Supervisor.
 - If the issue is still not resolved, contact the Technology Center Director.



Further Information

USPTO Useful Web Links - <http://www.uspto.gov>

Helpful Web Pages:

- Notices, Recent Patent-Related – a very current list of all Federal Register, Official Gazette and pre-Official Gazette notices, and certain Office memoranda:
<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>
- Forms Page – current USPTO forms available for use by the Public:
<http://www.uspto.gov/web/forms/index.html>
- Manual of Patent Examining Procedure (MPEP):
<http://www.uspto.gov/web/offices/pac/mpep/mpep.htm>



Further Information

USPTO Useful Web Links (cont'd)

- Mailing Addresses and Mail Stops:
<http://www.uspto.gov/web/offices/com/sol/og/patboxs.htm>
- Facsimile Numbers:
<http://www.uspto.gov/web/offices/com/sol/og/2005/week42/patcorr.htm>
- USPTO Glossary:
<http://www.uspto.gov/main/glossary/index.html>